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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/682,131	10/09/2003	Jerry I. Jacobson	35733-293661	1354
7590 04/22/2005		EXAMINER		
Cynthia B. Rothschild, Ph.D.			BRADFORD, RODERICK D	
Kilpatrick Stockton LLP 1001 West Fourth Street			ART UNIT	PAPER NUMBER
Winston-Salem, NC 27101-2400			3762	
			DATE MAILED: 04/22/2009	ς.

Please find below and/or attached an Office communication concerning this application or proceeding.

		<u> </u>				
	Application No.	Applicant(s)				
	10/682,131	JACOBSON ET AL.				
Office Action Summary	Examiner	Art Unit				
	Roderick Bradford	3762				
The MAILING DATE of this communication ap Period for Reply	pears on the cover sheet w	th the correspondence address				
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above, thes than thirty (30) days, a report of the period for reply is specified above, the maximum statutory period. - Failure to reply within the set or extended period for reply will, by statuly any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	136(a). In no event, however, may a ply within the statutory minimum of third will apply and will expire SIX (6) MON te, cause the application to become Al	eply be timely filed by (30) days will be considered timely. ITHS from the mailing date of this communication. BANDONED (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 09 (October 2003.					
2a) ☐ This action is FINAL . 2b) ☑ Thi	is action is non-final.	1				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under	Ex parte Quayle, 1935 C.[). 11, 453 O.G. 213.				
Disposition of Claims						
4) Claim(s) 1-23 is/are pending in the application	n.					
4a) Of the above claim(s) is/are withdra						
5) Claim(s) is/are allowed.						
6) Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) 1-23 are subject to restriction and/or	8) Claim(s) 1-23 are subject to restriction and/or election requirement.					
Application Papers						
9)☐ The specification is objected to by the Examin	ner.					
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the E	Examiner. Note the attache	d Office Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreig a) All b) Some * c) None of: 1. Certified copies of the priority documer 2. Certified copies of the priority documer 3. Copies of the certified copies of the pri application from the International Burea * See the attached detailed Office action for a list	nts have been received. nts have been received in A ority documents have beer au (PCT Rule 17.2(a)).	Application No received in this National Stage				
Attachment(s)						
1) Notice of References Cited (PTO-892)	Summary (PTO-413) s)/Mail Date					
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08 		nformal Patent Application (PTO-152)				
Paper No(s)/Mail Date	<u>_</u>					

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DETAILED ACTION

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Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a method of treatment or prophylaxis of a disease state or a condition in an organism, classified in class 607, subclass 2.
 - II. Claims 9-16, drawn to a device for invasively administering an electromagnetic field in an organism, classified in class 607, subclass 57.
 - III. Claims 17-23, drawn to a device for stimulating organ operation in an organism, classified in class 607, subclass 103.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I (process) and II and III (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus or by hand such as not being implanted in the body, but rather by a device that can be applied to the skin external.
- 3. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the

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particulars of the subcombination as claimed because the combination does not require an inductor. The subcombination has separate utility such as not requiring a capacitor connected to the solenoid, but rather an inductor.

- 4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject: matter, restriction for examination purposes as indicated is proper.
- 5. A telephone call was made to Cynthia Rothschild on April 7, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (571) 272-4942. The examiner can normally be reached on Monday - Friday 9 a.m. - 6:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RB

ANGELA D. SYKES SUPERVISORY PATENT EXAMINER TECHNOLOGY CENTER 3700

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